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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,586	09/18/2000	Glenn Adler	US000231	4088

7590 10/22/2003

Corporate Patent Counsel
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EXAMINER

BECKER, SHAWN M

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 10/22/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/663,586

Applicant(s)

ADLER, GLENN

Examiner

Shawn M. Becker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-9 are rejected under 35 U.S.C. 102(a)(b) as being clearly anticipated by the Sony CyberFrame PHD-A55 (hereinafter CyberFrame as supported by the product review in TechTV (hereinafter TechTV), the product description in Outpost.com (hereinafter Outpost), and the Sony Hong Kong Press Release dated April 19, 1999 (hereinafter Sony Press Release).

In the first paragraph of the Sony Press Release, it is established that the CyberFrame was released 4/19/1999. The first two paragraphs on page 2 of the Sony Press Release describe the CyberFrame product. Therefore, the CyberFrame product was made available to the public on 4/19/1999 and the TechTV and Outpost articles describe features of that CyberFrame product.

Referring to claim 1, the CyberFrame is a stand-alone monitor having an interface with a storage medium reader that reads a digital image stored on a storage medium. See the second paragraph in TechTV that describes how memory sticks (storage medium) are read to display images from a digital camera. There inherently has to be a controller to process and transfer the image from the memory stick to be displayed in the display screen of the CyberFrame. There necessarily must be some sort of controller/processor for moving the image data/file from the memory stick to the display screen. The third paragraph in TechTV describes a user-interface

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operable to enable issuing a command to the controller to control the reading and display of the digital images on the display screen. See how the user can navigate through the images, rotate the images, and set up a slide show.

Referring to claim 2, the CyberFrame inherently has to have an image buffer in order to perform the slide show capabilities as described in the fourth feature of Outpost. The images selected by the user to be displayed in intervals are read by the memory stick reader (storage medium reader) and transferred to an image buffer for storage and display on the display screen.

Referring to claim 3, the controller of the CyberFrame is also used to perform a task, unrelated to the interface for controlling the digital image. See in the Specifications of Outpost, how there is a date and time display and a clock set, which must be performed by a controller.

Referring to claim 4, the controller of the CyberFrame processes the read digital image into a format that is compatible with the signal input of the display. See the JPEG playback in the first listed Feature in Outpost.

Referring to claims 5-6, the CyberFrame's user-interface enables the user to manipulate the image displayed, such as deleting or protecting images (stored data), sequencing the display of multiple images (slide show), resizing and rotating images. See the third paragraph of TechTV and the fourth, sixth, and seventh Features in Outpost.

Referring to claim 7, the manipulations are performed via on-screen menu selection through the user-interface. One of the Specifications in Outpost is an on-screen menu.

Referring to claim 8, the display screen is an LCD. See the second Feature in Outpost.

Referring to claim 9, the storage medium is a memory stick. See the first paragraph in Outpost.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over CyberFrame and the article entitled "Sony's \$900 Picture Frame", by Mark Gimein.

The storage medium reader of CyberFrame is only capable of reading memory sticks. However, as Gimein points out other types of storage medium (formats) do a good job of storing digital images and other data. See the third paragraph on page 2. It would have been obvious to one of ordinary skill in the art to modify the storage medium reader of CyberFrame to be able to read two or more different storage media types to make the CyberFrame compatible with other vendor's storage technology as supported by Gimein.

Response to Arguments

5. Applicant's arguments, see the second paragraph on page 12, filed 8/4/03, with respect to the rejection of claim 3 under 35 U.S.C. § 112 have been fully considered and are persuasive in view of the amendment to claim 3. The rejection of claim 3 under 35 U.S.C. § 112 has been withdrawn.

6. Applicant's arguments regarding the rejection of claims 1-10 under 35 U.S.C. § 102 filed 8/4/03 have been fully considered but they are not persuasive.

Applicant argues that the date of the references was not well established or reliable. However, since the TechTV article was posted October 1, 1999 (publicly available through the Internet) and reviews the CyberFrame product, clearly, the CyberFrame had to be around prior to this date, which was indicated on the previous PTO-892 Notice of References Cited, mailed 4/4/03. The attached Sony Press Release indicates that the CyberFrame was actually publicly available at an earlier date, April 19, 1999. Therefore, the CyberFrame clearly qualifies as prior art and the TechTV and Outpost articles provide descriptions of features present in the prior art CyberFrame product.

Applicant argues that it is not inherent for there to be a controller to process and transfer the images in the CyberFrame. However, as described in the previous office action, mailed 4/4/03, a controller is inherent and necessary in the CyberFrame for an image to be transferred from memory (i.e. the memory stick) to the display. As described in each article, users of the CyberFrame may take pictures with a digital camera, store them on a memory stick, and display them with the digital CyberFrame by inserting the memory stick into the CyberFrame and selecting the images from an interface. In order for the communication to occur between the memory stick and the display, there must be some sort of controller/processor. Furthermore, there must be a controller for controlling the instructions from the user interface to retrieve certain images. See third paragraph of TechTV.

Therefore technical reasoning reasonably supports the inherent controller characteristic as is required by the reference cited by the Applicant. See *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

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Similarly, an image buffer is required to store the images that are to be in the slide show described in the fourth feature of Outpost.

Applicant provides no other technical possibilities for how the image gets from the memory stick to the display without a controller nor how the slide show in the fourth feature of Outpost could be performed without an image buffer.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

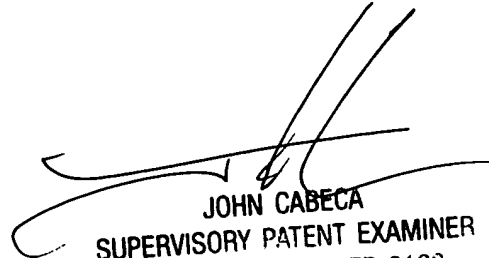
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawn M. Becker whose telephone number is 703-305-7756. The examiner can normally be reached on M-Th 8:00 - 5:30 and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Cabeca can be reached on 703-305-3116. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

smb



JOHN CABECA
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